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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,591	12/14/2001	Lesa Satchell	S1342/7000 RJP	5698

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EXAMINER

LANEAU, RONALD

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,591

Applicant(s)

SATCHELL ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,31,32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. The amendment filed on 10/20/04 is entered. Claim 30 is canceled and claims 1-29, 31 and 32 are now pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
3. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly added limitations “comprising a first item; ..., the payment being received for the first item ordered from the website and a second item” are not disclosed in the Specification. Applicant is required to point out the exact paragraph and lines where this limitation is disclosed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4-7, 9-10, 12, 19 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mital (5,903,652).

Mital discloses a computer-readable medium with instructions recorded thereon, which instructions, that when executed, cause at least one processor in communication with a web site to (Abstract; Figs. 1-15; cols. 3-6);

Accept a data object from the web site describing an order (Figs. 1-15; cols. 3-5 and 7 - web site = electronic mall; data object = secure purchase order message); and

Transmit a notification upon receipt of payment for the order to initiate order fulfillment (col. 6).

Mital further discloses that the instructions define the acceptance of the data object further include instructions defining accepting the data object through a communication channel (Figs. 1-15; cols. 3-5, 7-8 - secure purchase order message sent through publicly accessible on-line network through to the specified merchant).

Mital further discloses that the instructions define accepting the objection further defines creating a self-contained module incorporating data and the processing to be performed on the data (Figs. 1-15; cols. 3-6 and 7-8 - secure purchase order which is encrypted).

Mital further discloses that the instructions define accepting the data object further define loading the data object to an electronic file storage (Figs. 1-15; cols. 3-6; cols. 13-14).

Mital discloses a computer-readable medium with instructions recorded thereon, which instructions, that when executed, cause at least one processor in communication with a web site to (Abstract; Figs. 1-15; cols. 3-6):

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Accept a first data object from the web site describing an order requiring shipment (Figs. 1-15; cols. 3-5 and 7 - web site = electronic mall; data object = secure purchase order message);

Accept a second data object from a point-of-sale module indicating a payment having been received for the order (cols. 14-15, 26, 29-30 - describes the POS module creating the credit authorization response);

Match the first and second object according at least one data element common to both objects (cols. 14-15, 26, 29-30); and

Transmit notification that a fulfillment operation is to commence (cols. 14-15, 26, 29-30).

Mital further discloses that the instructions define the acceptance of the first data object further include instructions defining accepting the first data object through a communication channel (Figs. 1-159 cols. 3-5 and 7-8 - data channel includes publicly accessible online network through to specified merchant).

Mital further discloses that the instructions define accepting the first data object further define loading the first data object to an electronic file storage (Figs. 1-15; cols. 3-6; cols 13-14).

Mital further discloses that the instructions define accepting the second data object further define loading the second data object to an electronic file storage (Figs. 1-15; cols. 3-6; cols. 13-14; cols. 28-30).

Method claim 19 is rejected for the same reasons set forth in computer readable medium claim 6.

System claim 29 is rejected for the same reasons set forth in computer readable medium claim 6. The "means for" language has been given the broadest reasonable interpretation and

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corresponds to the elements of claim 6. The examiner notes that the phrase "means for" was merely inserted before each claim element of claim 6.

6. Claims 13-15, 17-18, 21-25, 27-28, and 31-32 are rejected under 35 U.S.C. 10209 as being anticipated by Brian Alexander, The Kiosk, Where Brick Meets Click, The New York Times, December 13, 2000, pg. H18.

Alexander discloses a method for executing a transaction (a kiosk) comprising:

From a location at a vendor's place of business, a user initiating, from a terminal, an order from a web site affiliated with the vendor (kiosks located in a vendors place of business and linked to the vendor's web site enabling the customer to order merchandise directly - Store of Knowledge; Borders Kiosk where the web site is accessed through the intranet);

The vendor accepting payment from the user, at the place of business, in return for the order (Store of Knowledge where the kiosk in the vendors store, i.e. accepts payment in return for the order, Borders where the title was located by the kiosk but not found in the store and instructions were provided to go to in information desk to special order it); and

The vendor initiating shipment of the order to the customer, from a location separate from the place of business (Store of Knowledge's kiosk has merchandise shipped from a different location for items the store does not stock and Border's special orders the books ms they are not in stock at that location).

Alexander further discloses that when the user initiates the order it further includes transmitting data describing the order from the web site to a computer operated by the vendor for point-of-sale processing (Store of Knowledge's Kiosk links to a web site and allows purchases,

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i.e. transmits data to a computer operated by the vendor for point-of-sale processing, either by the Kiosk or Internet; Border's discloses that new kiosks will allow customers to swipe a credit card into a kiosk to pay for special orders and then have them shipped anywhere, i.e. the vendor's kiosk will transmit the order information to POS processing).

Alexander further discloses that the transmission of data includes that the data is transmitted over a communication channel (As both Store of Knowledge and Border's transmit data either internally within the kiosk or externally, there is interaction between different modules, i.e., there is a path or link through which the information passes between two devices, either internally or externally, the definition of a data channel).

Alexander further discloses that when the vendor accepts payment it further includes transmission that notification of received payment to a software module which performs fulfillment processing (Border's discloses that after the credit card is used to pay for the order, i.e. receipt of payment by a software module, the gifts can be shipped anywhere, performing order fulfillment; Store of Knowledge - ordered the gifts, i.e. paid for them and picked them up at a store nearby, software module fulfills order after payment).

Alexander further discloses that the transmission of the notification further includes transmission of notification over a communication channel (notification implicitly occurs over a communication channel because it is data being transmitted between different modules/servers/components and thus there is some medium for transferring information/carrying data in either analog or digital form - can be a physical link, such as the cable connecting two stations in a network, or it can consist of some electromagnetic

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transmission on one or more frequencies within a bandwidth, etc. - the definition of a communication channel).

Method claim 21 is rejected for the same reasons set forth in method claim 13.

System claim 31 is rejected for the same reasons set forth in method 21. The "means for" language has been given the broadest reasonable interpretation and corresponds to the elements of claim 21. The examiner notes that the phrase "means for" was merely inserted before each claim element of claim 21.

Alexander further discloses that the initiating occurs at a location separate from the vendor's place of business (Store of Knowledge's kiosk has merchandise shipped from a different location for items the store does not stock and Border's special orders the books as they are not in stock at that location).

System claim 32 is rejected for the same reasons set forth in method claim 22. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 22. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 22 and is broader in that it further comprises.

System claim 23 is rejected for the same reasons set forth in method claim 13. The "means for" language has been given the broadest reasonable interpretation and corresponds to the elements of claim 13. The examiner notes that the phrase "means for" was merely inserted before each claim element of claim 13.

System claim 24 is rejected for the same reasons set forth in method claim 14. The "means for" language has been given the broadest reasonable interpretation and corresponds to

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the element of claim 14. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 14 and is broader in that it further comprises.

System claim 25 is rejected for the same reasons set forth in method claim 15. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 15. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 15 and is broader in that it further comprises.

System claim 27 is rejected for the same reasons set forth in method claim 17. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 17. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 17 and is broader in that it further comprises.

System claim 28 is rejected for the same reasons set forth in method claim 18. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 18. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 18 and is broader in that it further comprises.

Mital further discloses that the instructions define the acceptance of the second data object further include instructions defining accepting the second data object through a communication channel (Figs. 1-15; cols. 14-15, 26, 28-30 - ms there is interaction between different modules there is a path or link through which the information passes between two devices, either internally or externally, the definition of a data channel).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mital (5,903,652).

Mital teaches as set forth above in claim 6 that teaches the use of a structural matching. However, Mital does not teach that the matching is performed by a human operator. Method claim 20 merely claims that the matching is performed by at least one human operator. This limitation is not given patentable weight because in order for it to be entitled to such weight in method claims, the recited structural limitation therein must affect the method in a manipulative sense and not amount to the mere claiming of a use of a particular structure. See *Ex parte Pfeiffer*, 135 USPQ 31, BdPatApp & Int 1961. The structural limitation in the instant method claims does not affect the matching manipulatively whether by human or by machine. As per system claim 30, it was well known at the time of the invention that merely providing an automatic means to replace an automatic activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91,95, 120 USPQ 193,194 (CCPA 1958). Thus, it follows that deautomating the step of matching, i.e. have the step performed by a human operator, provides the same advantages it previously provided prior to automation - a system that is always working (no network problems/computer errors), interactive client/customer exchanges to build valuable relationships and creates additional opportunities for

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cross-selling/upselling, etc. It is an analogous alternative. In other words, there is no enhancement found in the claimed step other than the previously known advantages. The end result is the same as the compared automated method. It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize a human in the matching step because this would benefit the vendor for the reasons set forth above and was previously being done.

9. Claims 3, 8, 11, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mital (5,903,652) or Brian Alexander, The Kiosk, Where Brick Meets Click, The New York Times, December 13, 2000, pg. H18 in view of Frank J. Derfler, Jr. & Les Freed, How Networks Work, , September 2000, pp. 200-201 and 206-207.

Mital and Alexander disclose as set forth above. However, neither Mital nor Alexander disclose the use of network firewalls in conjunction with computer readable media and instructions for transmitting data objects across them/transmitting data over a communication channel across a network firewall. Derfler, Jr. discloses that the purpose of a firewall is to securely separate the Internet and other external network for corporate lans and that firewalls use several different techniques to inspect the content, not just the destination of incoming packets to determine whether they warrant access (pg. 200). Derfler, Jr. further discloses that a firewall can be a function included in software running on a special server, which is available for a variety of operating systems and sets forth the best configuration as at least three parts (Internet, connection 1= adapter, corporate 1% adapter, 1= adapter linking firewall to protect lan) because this gives the firewall total control over the routing of each or these packets. (pg. 200) and that the network

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administrator can configure the firewall to deny access to many kinds of data, in order to improve the security of the system and remove possible holes in the firewall (pg. 200). Derfler, Jr. further teaches that firewalls protect networks against hackers and assist in eliminating the threat to data, thus protecting monetary stakes (pp. 206-207).

Thus, it would have been obvious to one of ordinary skill in the art to have included the use of network firewalls in conjunction with computer readable media and instructions for transmitting data objects across them/transmitting data over a communication channel across a network firewall in the computer readable medium, method and system claims of Mital and the method and system of claims of Alexander for the specific reasons set forth above.

System claim 26 is rejected for the same reasons set forth above as applied to method claim 16. The "means for" language has been given the broadest reasonable interpretation and corresponds to the element of claim 16. The examiner notes that the phrase "means for" was merely inserted before the claim element of claim 16 and is broader in that it further comprises.

Response to Arguments

10. Applicant's arguments filed on 10/20/04 have been fully considered but they are not persuasive.

Applicant's arguments are directed to the newly added limitations. Since there is a new matter situation on the newly added limitations, the Examiner is not responding to applicant's arguments at this time. The claims are finally rejected.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RL

Ronald Laneau
Examiner
Art Unit 3627

rl

Handwritten signature: Primary Examiner
Date: 1/21/05